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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,581	09/24/2003	Robert W. Stuckel	252060	5637
23460 7590 11/16/2007 LEYDIG VOIT & MAYER, LTD TWO PRUDENTIAL PLAZA, SUITE 4900 180 NORTH STETSON AVENUE CHICAGO, IL 60601-6731				
			EXAMINER LEE, LAURA MICHELLE	
			ART UNIT 3724	PAPER NUMBER
			MAIL DATE 11/16/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/669,581	Applicant(s) STUCKEL ET AL.	
	Examiner Laura M. Lee	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 1-21, 27 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-26, 29-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to the amendment filed 7/16/2007 in which claims 1-32 are currently pending, claims 1-21, 27,28 are withdrawn, and claims 22 and 32 are currently amended.

Response to Arguments

2. Applicant's arguments with respect to claims 22- 26, 29-32 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claim 32 is rejected under 35 U.S.C. 102(e) as being anticipated by Blank (U.S. Patent 6,588,658) as evidenced by Siegel (U.S. Patent 5,431,207). Blank discloses see (Figure 5) a method for cutting a financial card (sheet, 30) from a first configuration (Figure 5) to a second configuration (transaction card, 10) having a second periphery, said method comprising the steps of: supplying, to a

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cutting station (where the sheet is stamped or die cut; col. 9, lines 3-5), the financial card (30) having said first configuration and being wallet sized (as evidenced by Siegel Figure 6; see note below) and further having a functional magnetic stripe (13; col. 9, lines 8-12); cutting said wallet-sized financial card (30) at said cutting station (where the sheet is stamped or die cut; col. 9, lines 3-5) to form a cut financial card (transaction card, 10) being of said second configuration having said second periphery, such that at least a portion of the magnetic stripe remains of the cut card (10) and at least a portion of the magnetic stripe does not remain of the cut card (10; it is left on the sheet, 30, as evidenced by the dashed lines of Figure 5); and transporting said cut financial card away from (i.e. and providing the transaction card to the user) the cutting machine (stamping / die cutting machine); wherein the portion of the magnetic stripe remaining on the cut card (10) is still functional following the cutting step (encoding on or after cutting/ applying magnetic strip before or after cutting; col. 9, lines 8-12). It is noted that the limitation of "wall-sized" has not been interpreted to be only inclusive of men's wallets. The sheet as shown in Blank's Figure 5 is considered wallet-sized as evidenced by Siegel that shows in Figure 6, a ladies wallet, approximately the same size as Blanks, sheet 30. Both Siegel and Blank disclose 6 approximately equal sections that are all approximately the size of a typical credit card.

5. Claim 32 is rejected under 35 U.S.C. 102(b) as being anticipated by the standard method of disposing of unwanted credit cards, which are wall-sized, i.e.

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they fit inside a wallet. For example, the Examiner has disposed of unwanted cards by using a scissors and cutting the unwanted credit card in half perpendicular to the magnetic stripe more than five years ago. This method of disposing of unwanted credit cards anticipates the method for cutting a financial card from a first configuration having a first periphery to a second configuration having a second periphery, wherein the unwanted and uncut credit card is a financial card with a first configuration having a first periphery, and the left half of the financial card after the card is cut with the scissors is a financial card having a second configuration with a second periphery; supplying the financial card having said first configuration and a functional magnetic stripe to a cutting station is anticipated by the step of removing the credit card from my wallet and placing it in between the blades of the scissors; cutting the financial card at the cutting station to form a cut financial card being of the second configuration having the second periphery such that at least a portion of the magnetic stripe remains on the card is anticipated by operating the scissors to cut the credit card in half, wherein both halves of the credit card have a second configuration with a second periphery and a portion of the magnetic stripe; transporting the cut financial card away from the cutting station is anticipated by throwing the halves of the cut credit card into the trash; the portion of the magnetic stripe remaining on the cut card is still functional following the cutting step is anticipated by the cut halves of the credit cards still having magnetic strips that are capable of being swiped through credit card transaction machines.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Blank (U.S. Patent 6,588,658) as evidenced by Siegel (U.S. Patent 5,431,207) and in view of Christen et al. (U.S. Publication 2002/0046635), herein referred to as Christen. Blank discloses a method of cutting financial cards (sheet, 30) from a wall-sized first configuration (as shown in Figure 5, and as evidenced by Siegel; see note below) to a second configuration (transaction card, 10) having a second periphery at a cutting station (where the sheet is stamped or die cut; col. 9, lines 3-5). However, Blank is silent as to how the sheets are processed at the cutting station. Attention is therefore directed to the Christen card-punching machine. Christen discloses an improved cardpunch system that is adaptable to different card dimensions and achieves close tolerances and clean card edges. One having ordinary skill in the art would have been motivated to use the economical Christen card-punching system to achieve clean card edges and close card tolerances on the punched out (e.g. die cut) transaction cards of Blank. Therefore, the modified device of Blank discloses the method of supplying a succession of discrete, individual financial cards (Blank, 30 / Christen 10) to a cutting station (Christen 8, 9, 12, 13) as disclosed in paragraph [0014];

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cutting each financial card (Blank, 30 / Christen 10) in succession to form an individual cut financial card (Blank, 10; Christen, 17) and corresponding scrap (the edge of Blank, 30), each cut financial card (Blank, 10; Christen, 17) being of the second configuration having the second periphery; (element 10 of Christen and Blank sheet 30 becomes scrap after cutting); cut financial cards (Blank, 10; Christen, 17) are transported away from the cutting station, separately from the scrap, along passage 16 to delivery station 3, 4, 6; credit cards in paragraph [0004], line 1; element 12 is a cylindrical punching tool which punches a hole in the card having the first configuration 10; the scrap corresponding to each cut financial card is intrinsically discarded in succession. Note that the term discarded has been interpreted as merely being transported to another location, i.e. the trash, recycle bin, the floor. Furthermore, it is noted that the limitation of "wall-sized" has not been interpreted to be only inclusive of men's wallets. The sheet as shown in Blank's Figure 5 is considered wallet-sized as evidenced by Siegel that shows in Figure 6, a ladies wallet, approximately the same size as Blanks, sheet 30. Both Siegel and Blank disclose 6 approximately equal sections that are all approximately the size of a typical credit card.

8. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Blank, as evidenced by Siegel, in view of Christen in further view of Kline et al (2,430,720), hereafter Kline. The modified device of Blank discloses everything as noted above, but does not disclose a first conveyor that has a plurality of spaced nests. However, Kline teaches first conveyor in figure 2 that has a

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plurality of spaced nests 26. It would have been obvious to provide a first conveyor that has a plurality of spaced nests in the modified device of Blank as taught by Kline in order to automate the process of supplying cards to the cutting station.

9. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination Blank, as evidenced by Siegel, in view of Christen in further view of Kline as applied to claim 23 above, and further in view of Roy et al (5,586,479), hereafter Roy. The combination discloses everything as noted above, but does not disclose a magnetic stripe reader. However, Roy teaches magnetic stripe reader 58A, 58B in column 4, lines 30-68. It would have been obvious to provide a magnetic stripe reader in the combination as taught by Roy in order to determine the amount of skew of the cards.

10. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination Blank, as evidenced by Siegel, in view of Christen in further view of Kline as applied to claim 23 above, and further in view of Roy. The combination discloses everything as noted above, but does not disclose properly locating the card with a cutting device. However, Roy teaches properly locating the card with a cutting device in column 5, lines 19-42. It would have been obvious to provide a method of properly locating the card with a cutting device in

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the combination as taught by Roy in order to ensure proper cutting of a skewed card.

11. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination Blank, as evidenced by Siegel, in view of Christen, and further in view of Pentz (D462,965). The combination discloses everything as noted above, but does not disclose a non-conventional configuration of a smaller rectangular shape. However, Pentz teaches non-conventional configuration of a smaller rectangular shape in the figures. It would have been obvious to provide a non-conventional configuration of a smaller rectangular shape in Christen as taught by Pentz in order to allow a user to fit the card into rectangular wallet pockets.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory

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action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura M. Lee whose telephone number is (571) 272-8339. The examiner can normally be reached on Monday through Friday, 8:00am to 4:30pm.

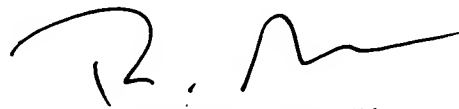
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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LML

10/06/2007



BOYER D. ASHLEY
SUPERVISORY PATENT EXAMINER